

Regulation for consideration of application for trade mark registration

Approved by Patent Agency within Ministry for Economy and Trade of the Republic
of Kazakhstan on 8 October, 1996

Recorded in Ministry for Justice of the Republic

- list of goods and/or services for which protection is asked for (minimum is name of one good or one service);

- signature, in compliance with par. 3. Regulation 1.

if one of the mentioned information points lacks, application is not considered to be handed-in, its documents are to be returned.

Application recorded cannot be returned.

Applicant or his/her representative is given a receipt on reception of application documents.

Application received for consideration goes through expertise by KazPatent in compliance with Art. 10 of the Law, of this Regulation and International Agreements concluded in the sphere of Trade Marks in 2 phases: preliminary expertise and complete expertise.

2.3.2. Priortization of the application, in compliance with Art. 9 of the Law, is established:

- by date of reception of documents and information by KazPatent, mentioned in par. 1. of this Regulation, or by date of submission of the latest document or information mentioned in par. 1. of this Regulation;
- by date of submission of the first

confirmation of duty payment for application letter of attorney submission, in compliance with par. 3. Art. 6 of the Law.

complete expertise.

3. Complete expertise

3.1. Tasks

Complete expertise identifies compliance of applied marking with demands made to trade marks from the point of protection ability formulated in Art. 14 and 15 of the Law.

Protection ability of the mark means legal property determined by aggregate of characteristics, needed for registration of marking as trade mark.

Besides, during phase of complete expertise data established in the preliminary expertise phase shall be verified (for example, prioritization or correctness of ICGS classification).

310, 320, 330 – priority data re application submitted earlier – correspondingly, number, date, country of application submission<*>
510, 511 – list of goods and services, grouped in ICGS classes
526 – elements excluded from protection<*>
551 – indication if mark is collective<*>
554 – indication that mark is volumetrical<*>
591 – indication of colour spectrum<*>
Reference. (<*> indication is given in relative cases).

Decision on registration of trade mark may be reconsidered by KazPatent if application with earlier priority given on the basis of international agreements for identical or similar indication is submitted. It can be reconsidered in connection with registration of name of origin of good and according to ex officio if additional circumstances were found out. Decision on registration (as final decision on denial) may be reconsidered on the basis of decision of commission of experts.

3.3.2. Decision on denial for registration (preliminary) is taken on the basis of expert conclusion on inconsistency between applied indication and terms of protection ability.

at that applicant is sent a decision on denial for registration in the established form (-7), where there are reasons for denial based on the Law, this Regulation and international agreements.

3.3.3. Objection for denial decision () is received by KazPatent within 2 months from the date of submission by applicant (applicant's representative) under condition of payment of relative duty. If document confirming duty payment is lacking, objection is not taken into consideration by the commission of experts. Period for objection submission may be extended at the instance of applicant for not more than 6 months under condition of payment of additional duty.

When decision on registration of trade mark is taken after repeated consideration, taking additional information or documents submitted by applicant into account, duty for issue of certificate is not imposed, at that duty for submission of objection for preliminary denial is taken into account.

in case of no objection for preliminary denial in the established period and no petition on extension of period for objection submission, then preliminary denial is considered to be final denial, no additional notice is given to applicant.

3.3.4. Decision on denial (final) is taken by commission of experts after study of all arguments given by applicant in case if the latest turned out to be insufficient for change of decision in favor of applicant. Decision on denial (-8) can be called in question by applicant through submission of objection to Court of Appeal not later than 3 months from date of reception of denial under condition of payment of relative duty.

3.3.5. Request of commission of experts may refer to different information and documents, lack thereof impede to final judgment re application. In case if commission of experts have valid doubts re reliability of any submitted document or information, commission of experts has a right for request of needed evidence from

applicant.

Request can refer, in particular, to:

- 1) submission of missing documents and information or to their correction;
- 2) need for change of classification, specification of list of goods, presentation by more concrete terms;
- 3) evidence of carrying out entrepreneurs' activity by physical person applying for registration of mark in his name;
- 4) extra charge of duty, if in the result of expertise additional classes of ICGS were found out;
- 5) applicant opinion re adverse indications found out as a result of search, if commission of experts have grounds to presume availability of circumstances which allow to take decision in favor of applicant, etc.

3.3.6. Request shall be replied and sent to KazPatent not later than 2 months from date of its reception. If the reply does not contain information and documents requested by experts, applicant can receive another request. In case of non-submission of requested documents within period established by established legislation, application is considered withdrawn, applicant is notified of it in a written form.

periods established for reply can be extended in the instance of applicant for not more than 6 months under condition of payment of relative duty.

3.4. Verification of absolute grounds for denial for registration of indication of trade mark is carried out on the basis of international agreements in the area of protection of industrial property and Art. 14 of the Law.

3.4.1. Application in the applied indication of State symbols – emblems and flags, shortened or full names of international intergovernmental organizations; official control, guarantee and marks of assays, seals, awards and other insignia (or similar up to confusion level) – can serve a ground for denial for its registration as trade mark.

Such indications can exist in the mark as non-protected elements, if they are not the only elements in the composition of the indication and if consent for its use was given by relative competent body or by its owner.

Reference fund for making expertise are documents of WOIS with indications protected in view of Art. 6-ter of Paris Convention, as well as other reference and information documents.

Application of particle KAZ in the trade mark as indication of nationality, is allowed exclusively for names of government enterprises and organizations, or by approbation of authorities.

3.4.2. Distinguishing feature is characterized to marks which do not have direct descriptive and/or associative link with goods or services, for indication thereof they are used. Absence of distinguishing feature is established if:

- indication is not integrated graphical picture, for example, separate lines, simple geometric figures, not connected with each other by common composition and not giving as aggregate some new level of perception;
- indication, having no wording character, consisting of combination of not fewer than three separate units of the language (letters and/or digits);

- indication is naturalist or sketchy picture of goods, and in relation to them protection is requested;
- indication is three-dimensional object, shape thereof is caused exclusively by functional destination;
- indication is generally adopted symbol or term
(that is, symbolizing branch, kind of activity; graphical symbol applied in sciences and engineering technology,
as well as lexical unit, peculiar to separate spheres of science and engineering

Reasons for denial for registration of these indications, in addition to Art. 15 of the Law, are Art. 6 bis and 10 bis of Paris Convention.

Commission of experts has a right for denial to register well-known mark in the name of the third persons for indication of

- among industrial standards, earlier registered or applied for registration in KazPatent.

To verify identity and similarity the following activity shall take place:

- search of identical or similar indications is carried out;
- degree of similarity between indications applied and found out is established;
- homogeneity is determined between applied goods and goods for which identical or similar indications were registered (applied).

At that those marks are taken into account for which 3-Year period from the date of registration validity suspension is not expired, in compliance with Art. 23 of the Law, as well as those marks which were denied for registration, and period for disputed decision is not expired.

3.5.1. Similarity of wording indications is determined by comparison:

- with wording indications;
- with combined indications, composition thereof include wording elements.

Similarity of wording indications may be sound one (phonetical), graphic (visual) and semantic.

3.5.1.1. Sound (phonetic) similarity is determined on the basis of such attributes

Depending on their position in the word, equivalents can be acknowledged, for example:

Kaz. graphics	Rus. graphics	Roman graphics
	=	SH=SCH=J=G
	=	T=D=GHT=TH
	=3=	S=C=Z=SS
=	= =	K=G=H
= = =	=	v=F=PH=FF=W
=I	=	P=B
=	=	CH=TCH
=	=	U=OO=YOU=OU
=Y=Y	=	E=Y=EE=EA=I
X=H=f	=	
	=	
	=	

Attributes listed may be taken into account as each separate and in different combinations.

Application of hieroglyphs, Arabic or other graphics shall be accompanied by transliteracy. At that search is made both by graphic image and by transliteracy.

3.5.1.2. Graphic (visual) similarity of wording indications is determined on the basis:

- general visual impression;
- kind of print;
- way of writing, including order of letters and alphabet;
- colour and colour combination;

Search is made among wording and graphic indications, Having wording character.

3.5.1.3. Semantic similarity is determined through perception of mark by Kazakhstani consumer according to criteria:

- coincidence of ideas;
- opposition of ideas;

Coincidence of one of the elements of the indication which has logical stress and can have independent meaning is taken into account.

3.6. Coincidence of graphic or volumetric indications is determined by the following attributes:

- external shape;
- availability or absence of symmetry;
- form and character of picture;
- combination of colours.

Colour and colour combination cannot be only attributes of trade mark, they can be considered its significant additional attributes.

Formation of automatized search image is made with application of International Classification of Graphic Elements, predominantly, of two first levels of gradation.

Search is recommended to be made according to the following scheme:

- geometric figures dominating in the graphic mark;
- dominating graphic figures, including separate letters and digits;
- aggregate of dominating elements;
- picture not dominating in the applied composition, but having composition completeness;
- labels, in addition to search by basic elements, are verified by index 25.1. - labels.

Search is made among graphic, combined indications, including graphic elements, as well as among volumetric marks.

3.7. Combined indications are studied for similarity of combined indications as a whole and for similarity of its separate elements. If identity or similarity up to confusion of separate elements (wording, graphic) is found out, the combined indication is not denied for registration as a whole.

3.8. Homogeneity of goods is determined with a view to find out compliance of the indication applied for registration with criterium of "protection ability".

goods are homogeneous if they fulfill the same function, refer to the same type (kind), which in marking by identical or similar marks may make consumer think of its belonging to the same manufacturer. Homogeneity of goods is determined by the following attributes: type (kind), destination, marketing terms, circle of consumers.

To determine homogeneity of goods the list of goods containing in the application is compared with list of goods, in relation to which the identical or similar trade marks were registered or applied.

Goods cannot be considered as similar only on that ground that they were referred to one ICGS class, belonging to the different classes is not evidence of their heterogeneity.

So heterogeneous goods are clothes and footwear, included into 25th class of ICGS, gloves included into classes 10,21 and 9, depending on their functional destination.

Corresponding classes, including homogeneous goods/services can be considered, for example,

- 1 and 5 – re chemical products for agriculture and pesticides
- 3 and 5 – re cosmetics and deodorants
- 16 and 41 – re printed production and publication of printed production
- 25 and 40 – re clothes and tailoring, etc.

4. Verification of payment of duty

Duty payment is verified, in compliance with approved Regulation on procedure of duty payment in phases of preliminary expertise and complete expertise through:
- verification of availability and validity of the document confirming duty payment.

If it lacks or is not submitted within established time application will be considered withdrawn, the applicant w

If error is found out, applicant is sent a request with offer to make a payment in compliance with mentioned properties

- verification of payment amount

If insufficiency of amount, established by Regulation on Duties for application submission is found out, applicant is sent relative request with offer to pay missing amount.

If insufficiency of amount established by Regulation on Duties for making expertise on all classes mentioned in application is found out, applicant is sent relative request with offer to pay missing amount. If Payment document confirming relative addition payment is not submitted, expertise will be made on the first classes mentioned in the application, in compliance with the amount of paid duty, if applicant did not make a request to change classification towards its decrease

- verification of terms of duty payment.

In case of duty payment, issue of protection document after 2 month period (but not later than 6 months), is offered to be paid by applicant as additional duty (in compliance with par. 17 of the Regulation on Duty Payment). Paper work on the application will be suspended until additional duty is not paid.

5. Changes, addenda, specifications and corrections

Corrections which do not change the application in essence, may be made in the application documents within 2 months from the date of its submission according to the written request of the applicant, without duty payment. After expiry of this period, introduction of the similar changes will be paid with relative duty.

Changes which do not influence on the application in essence are the following:

- change of name and/or address of applicant in any phase of expertise, if applicant remains the same;
- change of applied or registered indication, not influencing on its general perception (visual or phonetic image) and not able to cause infringement of rights of applicants with later date of submission;
- change of list of goods inside applied classes if they are homogenous.

If change of name or address of applicant is result of conclusion of contract, the name of the previous applicant, name of the new applicant are mentioned in the petition, as well as fact of their mutual consent is certified. Introduction of similar changes is accompanied by duty payment ofr petition on conceding a right for issue of protection document. Significant change of applied indication, or extension of list of goods and increase of classes of ICGS, as well as increase of homogenous goods inside class mentioned in the primary documents of the application are considered by commission of experts as significant changes. At that applicant is offered to make his/her own application.

5.1. Application division at the instance of applicant may take place in any phase of its consideration and appeal up to taking final decision by distribution of goods and/or services listed in the primary application. Such applications preserve date of submission of the primary application, as well as number with additional code.

5.2. Registration division at the instance of applicant can be made through distribution between registratons of goods, in relation to which the trade mark was

registered. It can also take place in case of appeal by the third persons on acknowledgement of registration invalid

10. Registration Annulment

trade mark registration can be annuled in connection with:

- suspension of its validity period;
- on the basis of decision issued by authorities (Appeal Counsel or court bodies);
- in case if registration is considered invalid in compliance with Art. 28 of the Law;
- if legal entity is liquidated or practical activity of the legal person discontinued, if assignee lacks, by petition of the third persons;
- on the basis of application of the Trade Mark owner.

Registration is considered annuled from the date of introduction of information on annulment into Government Register of Trade Marks. Information on annulment of trade marks is published in the official booklet of KazPatent.

This Regulation becomes valid from the date of its official publication.